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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,060	06/13/2000	Tatsuya Eguchi	52178-020	5731

20277 7590 05/05/2004  
MCDERMOTT WILL & EMERY  
600 13TH STREET, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER
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EDOUARD, PATRICK NESTOR

ART UNIT	PAPER NUMBER
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2634

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/593,060

Applicant(s)

EGUCHI ET AL.

Examiner

Patrick N. Edouard

Art Unit

2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Office Action is in response to communication filed 02/19/01 (paper #8). Claims 1-18 are pending.

#### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### ***Claim Rejections - 35 USC § 112***

3. Claims 1-5, 10 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation "each group including the translated document data translated in a common language that is different from each other group" is vague and indefinite. It is unclear whether this limitation means "each group is different from each other because one, two or three languages in the plurality of language is/are different but the translated document is in common" or "each group has completely different language except the translated document data" or "each group has a language in common, including the translated document data. In fact, this limitation does not define the metes and bounds of the claim.

*Response to Arguments*

4. Applicant's arguments filed 02/19/04 have been fully considered but they are not persuasive. Because of the following reasons:

A) In response to Applicant's argument that the combination of Yamauchi with Flores does not teach the claimed invention "each group including the translated document data translated in a common language that is different from each other group". The examiner cannot concur. In fact, the features upon which the Applicant relied upon have been rejected under 112 para. For being vague and indefinite and does not set the metes and bounds of the claims.

B) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yamauchi et al teach □ a controller, (col., 7, lines 55-56, the system includes a system controller for controlling each unit); wherein in a case where the first mode is set, said controller controls translating means so as to translate the document data and to output the translated document (col. 4., lines 36-60, (when the first mode is activated, the first output means will output the received document in the first language and the second output will output the received document in the second language); the system will output the translated into a plurality

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of languages, and controls said output unit so as to output the translated document data by same language group"; and

"wherein in a case where the second mode is set, said controller controls said translating means so as to translate the document data"(when the second output means is activated the output means will output the received simultaneously in said first language and second language).

It is noted that Yamauchi et al teach the claimed invention but does not explicitly teach translating the received document into a plurality of languages. However, this feature is well known in the art as evidenced by Flores et al teach an apparatus for translating an original text into a plurality of languages in figure 4, col. 5, lines 27-57. Therefore, one having ordinary skill in the art at the time the invention was made would have it obvious to translate the received document as taught Yamauchi into a plurality of languages because it would be beneficial to monolingual and multi-lingual users attempting to find or create a particular work for content comparison in multiple languages.

C) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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5. Claims 1- 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al (5,701,497) in view of Flores et al (6,370,498) as set forth in prior Office Action mailed 11/20/03 (paper #7).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

4. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231 or faxed to:

(703) 308-9051, (for formal communications intended for entry) Or:

(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park 11, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick N. Edouard whose telephone number is (703) 308-6725. The examiner can normally be reached on Tuesday-Friday from 07:30 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (703) 305-9645.

The facsimile phone number for this Art Unit is (703) 305-9508. Alternatively, facsimile messages may be sent directly to (703) 305-9644 where they will be stored in the examiner's voice mailbox (telling the examiner that a fax was received) and be automatically printed (i.e. - no delay by the examiner).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Patrick N. Edouard

April 29, 2004

  
PATRICK N. EDOUARD  
PATENT EXAMINER